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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,434	07/09/2003	Abner E. Moreau JR.	37355-181	9173
5514	7590	11/01/2005		
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER LE, THIEN MINH	
			ART UNIT 2876	PAPER NUMBER

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

EL

Office Action Summary	Application No.	Applicant(s)	
	10/616,434	MOREAU ET AL.	
	Examiner	Art Unit	
	Thien M. Le	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The amendment filed 8/8/2005 has been entered. Claims 1-20 remain for examination.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Stimson et al. (herein after referred as Stimson – 5,777,109).

Regarding claim 1, Stimson discloses a pre-paid card system enables customers to make purchases using an authorized card. The system includes four main functional components: a plurality of cards, a host computer, a plurality of on-site activation terminals and a main processor. Each of the cards having a security number associated therewith. The card is typically formed of cardboard, paper or plastic and may include the security number in clear text under a suitable blackout. The main management and processing of the system is effected by the host computer. The host includes a database for storing security numbers associated with authorized cards. The data terminals are remote from the host computer and connectible thereto for transmitting data between the terminals and the host computer. The processor is controlled by the host computer for enabling customer purchases using the authorized cards.

Figure 4 of Stimson shows a prepaid card transaction system comprising a network 58 which is served as the claimed central hub for communicating between the the merchant terminal 52 (considered as agent) and a host computer/main processor 54/56. According to Stimson, the activation procedure including the process of submitting the request for approval from the merchant terminals 52 to the main processor 54 via the network. The main processor will determined whether or not the account is approved and then send a status report to the merchant terminal 52 [see figure 4, col. 7, lines 25-60).

As can be seen, Stimson discloses the claimed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stimson et al. (Stimson – 5,777,109; cited above) in view of Ross, Jr. et al. (herein after referred as Ross – 6,629,135).

Regarding claim 2, see the discussions regarding claim 1. The claim differs in calling for a Website which is served as the claimed hub for providing communication between the agent and the card issuer/processor.

Reference to Ross is cited as evidence showing the conventionality of the use of a website as a liaison between the agent/agent and the card issuer/processor.

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Specifically Ross discloses a system and a method for providing communications between the host processor/issuer and merchants and customers. According to Ross, the process flow for a prospect to become a Host and be fully able to endorse/promote/offer Merchant products is as follows: a) Hosts are recruited from three sources: direct recruiting, in which the Host prospect is identified by and approached by an e-commerce outsource provider representative; passive recruiting, in which the Host has been referred to the outsource provider by other Hosts, relevant meta-sites (sites that contain lists of and links to other sites/services), or other sources; and Host Agent recruits, in which a specialized third party Agent identifies and approaches Host prospects. In many cases, the use of online signup forms and brochures may be a factor in recruitment. b) Prospect completes the Host application form (except where preapproved), providing information about the type of website(s) operated by the Host, some traffic statistics about these websites and general visitor demographics, and complete contact information. The prospect also selects an outsource provider system user ID and password which will later be used to access the system, retrieve important Hosting information and programming, and modify the custom materials in the outsource provider transaction processing engine. c) The application is received and the information therein is reviewed, and the application is either approved or rejected (unless this is a preapproved Host). If approved, the Host's ID and password are activated, and an automated message is sent to the new Host informing them of their approval. This message will also contain instructions for accessing the e-commerce outsource provider system, setting up their links to the

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outsource provider, and inserting outsource provider data into their website(s).

Preapproved Hosts will be immediately able to access this system upon submission of their application. d) Host accesses e-commerce outsource provider system to begin the step-by-step setup process. The Host first identifies a page from their own website which will provide the look and feel to be replicated. Following this, the Host configures product selections for each of its approved Merchants and downloads product images, text, and CGI/HTML code for their own website. Host then completes changes to website and activates new content. Hosts are free to promote their use of the outsource provider as they feel is suitable to the product at any time and with any frequency, subject to reasonable limitations. e) Hosts will be able to access real-time reports about transaction volume including number of users, average purchase amount per user, number of purchases on specified days or within specified date ranges. Hosts can create customized reports to determine conversion rates, top selling products, commissions earned, paid, and due, and other pertinent information. This information can be leveraged by the e-commerce outsource provider and the Host to improve the efficacy of targeted marketing efforts on the Host's website. Ross further discloses the use of the Website for monitoring merchant and customer transaction histories (see col. 4-26).

As can be seen, though Stimson is silent about the use of a website serving in the claimed manner, it would have been obvious to incorporate this limitation in Stimson's system. Reference to Ross is cited as evidence showing the conventionality of the use of a website as a liaison between the agent/agent and the card

issuer/processor. The modification merely extends Stimson's teachings by providing a medium for communication among the agents, the card issuer/processor and the card holders; and thus increases the versatility of Stimson's system.

Regarding claim 3, the host's websites are provided on the Internet which would embrace the limitations set forth in this claim.

Regarding claim 4, Ross discloses the method of communicating information over secure HTTP connections (i.e. HTTP over SSL). Ross also discusses the use of secure server and interfaces which thus would embrace all limitations set forth in this claim.

Regarding claim 5, see the discussions regarding claim 2. As can be see, the application submitted to the host's websites from the merchants or customers are processed automatically and in real-time; and thus would embrace all limitations set forth in this claim.

Regarding claim 6, see the host process flow as discussed in claim 2 for the approval and rejection of requested application.

Regarding claim 7, see the discussions regarding claim 2. Further, see col. 15-18 of Ross for the contents of the reports, including statistic data such as monthly revenue of the merchants, etc.

Regarding claim 8, see the discussion regarding claims 2-7 above.

Regarding 9, Ross discloses the use of merchant's manager page for recording and reporting changes; and thus would embraces all limitations set forth in this claim. [see figure 23 of Ross and its descriptions).

Regarding claim 10, see the discussions regarding claims 2-9. Specifically, Ross discloses the use of application servers for serving multiple host's websites; and thus would embrace all limitations set forth in this claim.

Regarding claims 11-20, the claims recite various combinations of the limitations have been address above.

Remarks

Applicant's arguments filed on 8/8/2005 has been fully considered but are not considered persuasive.

1. Applicant's assert in the remarks that:

"Stimson teaches activating a pre-paid card by utilizing an activation terminal (52) to enter and transmit information to a host computer (56), which in return provides a response message to the activation terminal (52). (See, eg. , Col. 7, lines 26-45 and Fig. 4.) Stimson's card activation or recharging scenario does not make any disclosure related to "submitting a merchant application for receiving transaction card usage approval," as recited in Applicants' claim 1. In fact, Stimson makes no disclosure of a merchant application" at all."

*** The examiner respectfully disagrees.

Page 3 of the Office Action dated 4/25/2005 recites the steps in which the merchant terminal sending request for activation approval of the prepaid card. The examiner is of the views that this "request for activation" is the claimed "merchant application".

Claim 1 does not recites any other limitation supporting the phrase "merchant application" which is different than a mere "activation request" as disclosed by Stimson.

2. Applicant asserts that "However, Stimson does not make any disclosure or provide any teaching of a system which may be used to automatically establish a location (e.g., a merchant's store-front or Website location) as one that accepts a transaction card as payment."

*** The examiner respectfully disagrees.

Claim 1, as originally submitted and currently maintained, does not include the limitations as argued.

3. Regarding applicant's arguments with respective to the grounds of rejection under 103.

The examiner respectfully disagrees.

Claim 1 as recited, does not recited any positive limitations which define over the teachings of Stimson (as has been discussed in the Office Action dated 4/26/2005).

Though asserting that the combination of Stimson and Ross is not obvious, applicant fails to provide any reason why the combination set forth in grounds of rejection of the Office Action dated 4/26/2005.

3. For these reason, the examiner respectfully maintains all grounds of rejection in this instant application.

This Office Action has been made FINAL.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thien M. Le whose telephone number is (571) 272-2396. The examiner can normally be reached on Monday - Friday from 7:30am - 4:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Le, Thien Minh
Primary Examiner
Art Unit 2876
March 9, 2005